

REMARKS

Amendments to the Claims

Claims 38-44 have been added. The newly added claims are supported by the specification at, for example, page 6, line 16, through page 7, line 19, page 10, lines 17-27, and Example 1. No new matter has been added by way of the addition of claims 38-41.

Restriction Requirement and Election

The Office has set forth an election of species requirement. Applicants elect, with traverse, a replication-deficient adenoviral viral vector comprising a nucleic acid sequence encoding pigment epithelium-derived factor or a therapeutic fragment thereof, wherein the adenoviral vector lacks all of the E1 region, part of the E3 region, and all of the E4 region. In response to a previous restriction requirement, applicants elected an adenoviral vector including the CMV promoter. Claims 1, 4, 5, 6, 8, 9, 11-15, and 18-27 encompass the elected species. Applicants note that, if and when the generic claim embracing the elected species is allowed, the nonelected species, if included in dependent claims incorporating all of the limitations of the generic claim, will no longer be withdrawn from consideration since they also would be fully embraced by the generic claim. M.P.E.P. § 809.02(c).

Reconsideration of the requirement for election of species is respectfully requested.

Discussion of the Restriction Requirement

The Restriction Requirement states that the Amendment filed December 19, 2002, increased the number of specific adenovirus vectors claimed as part of the invention, thereby necessitating an election of species. Applicants note that the amendments to the claims set forth in the Amendment of December 19, 2002, served to incorporate the subject matter of claims 4 and 6 into claim 1. Accordingly, the amendment did not increase the number of specific adenoviral vectors claimed as part of the invention.

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, *and* (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*” (M.P.E.P. § 803, emphasis added). In the case at hand, the Office fails to meet the above-identified criteria and to present the required supporting evidence and reasoning. The Office has failed to show separate classification, separate status in the art when classifiable together, or a different field of search with respect to the subject matter of the pending claims. The nature of the species set forth in the Restriction Requirement is such that a search for prior art

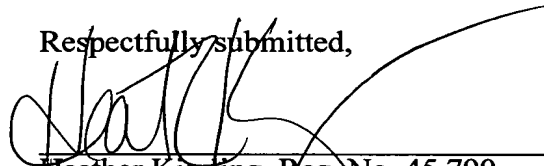
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related to one species likely would identify prior art of relevance to another species. For example, a search relating to an adenoviral vector lacking *all* of the E1 region and *all* of the E4 region (e.g., species III set forth in the Restriction Requirement) would identify art relating to an adenoviral vector lacking *part* of the E1 region and *part* of the E4 region (e.g., species I set forth in the Restriction Requirement). The Office has not even so much as alleged that there would be a serious burden on the Examiner if restriction were not required. Thus, the Office has failed to meet the criterion for a proper requirement for election of species.

Conclusion

For the above reasons, the Office has failed to satisfy the requirements for a proper restriction requirement, and Applicants request withdrawal of the restriction requirement. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,



Heather Kissling, Reg. No. 45,790
One of the Agents for Applicants
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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